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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

555255012288

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on 03/22/2006

Signature Debra L. Pejeau

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Application Number

10/004,001

Filed

11/01/2001

First Named Inventor

Wen Zhao

Art Unit

2643

Examiner

Pham, Tuan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 47,919

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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3/22/06  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 555255-012288

Group Art Unit: 2643 )  
Examiner: T. Pham )  
Inventor: Zhao, et al. )  
Serial No.: 10/004,001 )  
Filed: November 1, 2001 )  
For: Multifunctional Keyboard For A )  
Mobile Communication Device And )  
Method Of Operating The Same )

**PRE-APPEAL BRIEF  
CONFERENCE REQUEST**

**CERTIFICATE OF MAILING**

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By

*Debra L. Bejani*

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Applicant hereby requests review of the Final Rejection of the above-captioned application prior to filing an appeal brief for the reasons set forth below. The Applicant submits that the Final Rejection is based upon clear errors in fact and fails to establish a *prima facie* rejection.

## **REASONS FOR PRE-APPEAL CONFERENCE REQUEST**

### **I. PROSECUTION SUMMARY**

Claims 1-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Dayton et al. (U.S. 6,115,704). Claims 18 and 27-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dayton in view of Goodwin et al. (U.S. 6,218,966). Claims 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dayton in view of Miller (U.S. 5,660,488). Claims 36-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dayton in view of Goodwin and further in view of Miller. The Applicant traversed these rejections in an Amendment dated October 4, 2005 and amended claim 1 to “better define and make it more clear that the software automatically determines whether the output signals are to be converted into character codes or telephony signals.” (p. 10). In a Final Office Action dated December 22, 2005, the Examiner considered the Applicant’s arguments, found they were not persuasive, and maintained the rejection of the claims.

### **II. THE REJECTION OF CLAIMS 1 AND 30 CONSTITUTES A CLEAR ERROR OF FACT**

The rejection of claims 1 and 30 constitutes a clear error of fact because the cited references fail to disclose a keyboard mode control software module that automatically determines whether keyboard output signals from letter keys are to be converted into character codes or telephony tone signals, depending on which one of the plurality of software applications is active. As explained in detail in response to previous office actions, the cited Dayton reference does not disclose software applications, but rather describes different keyboard modes that are activated by pressing a button on the device. Moreover, even assuming *arguendo* that Dayton did disclose software applications (which it clearly does not), the Dayton reference does not contemplate more than one application running at the same time,

such that the device may take into consideration the “active” application to be sure the keyboard transmits the appropriate codes or signals. That is, Dayton does not select a keyboard mode based on which application is active. For at least these reasons, the Applicant submits that the rejection over Dayton constitutes clear error and cannot stand.

As described in the specification, the systems recited in claims 1 and 30 enable several applications to be launched and running on the device with only one application being “active.” For example, a user of the device of claims 1 or 30 could start a word processor software program on their device. When the word processor program is started it will be active, and the associated keyboard mode, e.g. data mode, will be automatically engaged. The user could then start a telephone dialing program while the word processor is running, and make the telephone dialing program active. Making the telephone dialing program active would automatically engage the associated keyboard mode, e.g. telephony mode. (See Specification, pp. 9-10). In this manner, a keyboard mode is automatically selected based on which application is active. Dayton does not contemplate this.

In Dayton, key mapping to a particular key function is not based on which of a plurality of applications is active, but is based on which key is pressed. Further, if the user wants to switch between a different use of the keyboard within a mode in Dayton, then the user must press a button to indicate to the device which mode he or she wants to use. For example, Dayton explains that when using the “store operation,” “[d]ialable telephone numbers may be entered and stored, either alone or embedded in the text of other messages, but must be identified by actuation of the NUMBER key before the telephone number digits, and actuation of the ENTER key at the end of the digits.” (Dayton, col. 6, ll. 53-57). Clearly, this has nothing

to do with which of several applications are active. For at least this reason, the Applicant submits that the rejections over Dayton constitute clear error and cannot stand.

## **II. THE OFFICE ACTION FAILS TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS WITH RESPECT TO CLAIM 18**

The rejection of claim 18 fails to establish a *prima facie* case of obviousness, and therefore must be withdrawn. In the Final Rejection, the Office Action acknowledged that Dayton does not anticipate all of the elements of the claims. However, it is unclear from the Office Action which elements are not cited in Dayton because the Office Action does not even attempt to show correspondence between the cited references and the elements of the claims. (See, Final Office Action at p. 10). The Examiner, in the Final Rejection, writes:

It should be noticed that Dayton fails to teach a plurality of software applications stored in a memory of the communication device and executed by the processor, the plurality of software applications each having an associated keyboard mode, the keyboard mode control software module being operable to automatically determine the keyboard mode associated with an active one of the plurality of software applications, wherein the keyboard mode is used by the keyboard mode control software module to automatically determine whether the keyboard output signals from the letter keys. However, Goodwin teaches such features (see col. 7, ln. 15-32, it is inherently that the word processor program is stored in the memory, and a keyboard mode control software module is build-in the CPU 14).

(Id. at pp. 10-11).


Significantly, this rejection wholly ignores the language of claim 18. For example, claim 18 recites “accessing the service store memory location to detect whether the telephony mode or the data mode is associated with the active application.” This language is not addressed at all in the rejection of claim 18. For this reason alone, the rejection of claim 18 cannot stand.

Moreover, a proper rejection of claim 18 cannot be made because the cited references do not teach or suggest detecting whether a telephone mode or a data mode is associated with an active application, as explained above. Indeed, the cited Goodwin reference is wholly unrelated to anything recited in claim 18, relating instead to tactile responses. For at least these reasons, the rejection of claim 18 is clearly improper and must be withdrawn.

For the above reasons, Applicant respectfully submits that the pending claims are allowable, and requests the withdrawal of the rejections.

Respectfully submitted,

JONES DAY



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